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10/022,491	12/18/2001	Stephen G. Malloy Desormeaux	83096ARLW	4283

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EXAMINER	
YE, LIN	

ART UNIT	PAPER NUMBER
2615	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,491	MALLOY DESORMEAUX, STEPHEN G.	
	Examiner	Art Unit	
	Lin Ye	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/18/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-7, 13-16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellegara et al. U.S. Patent 5,845,166 in view of Yamakawa et al. U.S. Patent 6,217,515 and Yamamoto et al. U.S. Patent 6,683,650.

Referring to claim 1, the Fellegara reference discloses in Figures 6-7, 14 and 19, a method for managing electronic images, said method comprising: capturing a first plurality of electronic images in a camera (e.g., digital images corresponding to images captured on the first photographic film in the hybrid image capture mode, see Col. 9, lines 65-67); filling memory in said camera to capacity with said first plurality of electronic images (image storage section 127 of the flash memory 126, see Col. 13, lines 17-31); capturing a second plurality of electronic images in said camera (digital images corresponding to images captured on the second photographic film in the hybrid image capture mode), following said filling; selectively assigning individual electronic images to the album image storage section (125) of the memory 126 (See Col. 16, lines 23-30); during said capture of said second plurality of electronic images, replacing the images in the image storage section (127) of the

memory (126); retaining the images in the album image section (125) (See Col. 13, lines 27-31) during said replacing; downloading together the tagged electronic images (e.g., the digital images captured in hybrid mode has the frame number tag of a corresponding photographic file images, see Col. 15, lines 56-59) and said untagged electronic images (e.g., the digital images captured in digital capture mode and stored on the memory without a frame number tag) to provide a set of downloaded images external to said camera as shown in Figure 19 (See Col. 19, lines 8-39); and retaining said tags in said downloaded images corresponding to said tagged electronic images (e.g., the download album images always include an ID file which contains tag, and image information file and an image data field as shown in Figure 14). However, the reference does not explicitly show using the tags to selectively mark the interested images for retaining purpose in the memory and only overwriting the untagged (uninterested) images in the memory on a first in-first out basis instead that storing the interested images in the album section.

The Yamakawa reference discloses in Figure 3, an electronic image memory (cine memory 4) for storing a plurality of image data sets, and storing a plurality of the newest image data sets by overwriting the stored oldest image with the newest images (e.g., first in first out overwriting method, see Col. 3, lines 40-43); and the image memories tagged with marks are skipped are not overwritten (See Col. 4, lines 11-22). The Yamakawa reference is evidence that one of ordinary skill in the art at the time to see more advantages that the electronic images system using the tags to retain some particular images in the memory for future review without overwriting by other newest images when the maximum capacity of image memory is reached, also the system do not need to require a additional space in the

memory for storing these particular images. For that reason, it would have been obvious to the system using the tags to selectively mark the interested images for retaining purpose in the memory and only overwriting the untagged (uninterested) images in the memory on a first in-first out basis disclosed by Fellegara.

The Fellegara reference does not explicitly show the camera system can selectively terminate tagged images as untagged images, the terminating being independent of said capturing.

The Yamamoto reference discloses in Figures 4-5, the digital camera can selectively assign a tag to the image on the display with a key mark for protecting the image, and the image will not be erased (see Col. 4, lines 37-40); the camera operator also can select a protect mode and terminate (the protection is cancelled) the tag (key mark) from the image independently (See Col. 4, lines 46-53). The Yamamoto reference is evidence that one of ordinary skill in the art at the time to see more advantages that the camera system has more flexible option to assign or terminate the tag from the image so that camera operator can easily decide to retain or erase the image data in the camera in any time. For that reason, it would have been obvious to the camera system can selectively terminating tagged images as untagged images independent of said capturing disclosed by Fellegara.

Referring to claim 4, the Fellegara reference discloses capturing latent images on photographic film (See Col. 6, lines 1-28).

Referring to claim 5, the Fellegara reference discloses capturing of said electronic images (e.g., in hybrid capture mode), capturing corresponding first and second pluralities of latent images on photographic film (see Col. 9, lines 65-67 and Col. 10, lines 1-7).

Referring to claim 6, the Fellegara reference discloses in hybrid image capture or film capture mode, loading a first film unit into said camera prior to said first capturing step and replacing said first film unit with a second film unit during said first capturing step. (e.g., new film cartridge can be loaded in the film transport unit when last film is rewound into the cartridge, see Col. 9, lines 62-67 and Col. 10, lines 1-6).

Referring to claim 7, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed with respected to same comment as with claim 1, and the Fellegara reference discloses wherein said second plurality is less than said first plurality (e.g, the Fellegara reference shows the film transport unit 60 has various sensors, including a film perforation sensor and cartridge sensors to provide information regarding the type of the film cartridge, this will be considered as the camera system can take any type of the film cartridge which has different frame number. Inherently, second plurality of electronic images corresponding with the photographic images in the second film cartridge could be less than the first plurality of electronic images corresponding with the photographic images in the first film cartridge) prior to said terminating (e.g., as discussed in claim 1, theYamamoto reference shows the user can camera operator can easily to retain or erase the selected image data in the camera in any time, so it would obvious that Fellegara camera system can load the second cartridge film and capture a plurality second plurality of electronic images prior to said terminating).

Referring to claim 13, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed with respected to same comment as with claim 1.

Referring to claim 14, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed with respected to same comment as with claim 4.

Referring to claim 15, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed with respected to same comment as with claim 5.

Referring to claim 16, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed with respected to same comment as with claims 1, and the Fellegara reference discloses in Figure 6, a hybrid electronic-film camera for use with photographic film units (14), said camera comprising: a body (10, in Figure 1); an electronic capture unit disposed in said body, said electronic capture unit (16) capturing a sequence of electronic images; memory (126) disposed in said body in operative relation to said electronic capture unit, said memory storing said electronic images, said memory having a predetermined storage capacity as shown in Figure 7 (See, Col. 3, lines 44-61 and Col. 13, lines 16-31).

Referring to claim 18, the Fellegara reference discloses a film capture unit (14) capable of selectively capturing a plurality of latent images on said film (See Col. 5, lines 6-20).

Referring to claim 20, the Yamamoto reference discloses wherein said tag selector selectively untags individual ones of said tags (e.g., in protect mode, see Col. 4; lines 46-58).

3. Claim 2, 8-12 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Fellegara et al. U.S. Patent 5,845,166 in view of Yamakawa et al. U.S. Patent 6,217,515, Yamamoto et al. U.S. Patent 6,683,650 and Kuno U.S. Patent 6,567,121.

Referring to claim 2, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed in respected claim 1, except the references do not explicitly show the camera system also be able to terminate said tags of said tagged images in said memory responsive to said downloading.

The Kuno reference discloses in Figure 1, a camera system including a storage device (6); the images data are stored in the storage device (6) with a tag (e.g., client registration information), when the storage capacity of each client is about to be exceed, the images are downloaded to the client; the client user may select images to be erased, and the server may erase the selected images (e.g., this can be considered as the storage device is responsive to the downloading to terminate the tagged image for erasing, see Col. 4, lines 59-67 and Col. 5, lines 1-5). The Yamamoto reference is evidence that one of ordinary skill in the art at the time to see more advantages that the camera system can terminate the tagged images responsive to the downloading so that user can remotely decide which images should be erased or overwriting in the memory. For that reason, it would have been obvious to the camera system also be able to terminate said tags of said tagged images in said memory responsive to said downloading disclosed by Fellegara.

Referring to claim 8, the Fellegara, Yamakawa, Yamamoto and Kuno references disclose all subject matter as discussed with respected to same comment as with claims 1-2 and 4.

Referring to claim 9, the Fellegara reference discloses wherein said capturing of each of said latent images is concurrent with said capturing of a respective one of said electronic images in hybrid capture mode (See Col. 9, lines 65-67, Col. 10, lines 1-5).

Referring to claim 10, the Fellegara reference discloses wherein each of said electronic images corresponds to one of said latent images (See Col. 15, lines 55-60).

Referring to claim 11, the Fellegara reference discloses wherein said latent images are captured in a plurality of film units and said method further comprises sequentially loading a plurality of film units into said camera (e.g., new film cartridge can be loaded in the film transport unit when last film is rewound into the cartridge, see Col. 9, lines 62-67 and Col. 10, lines 1-6).

Referring to claim 12, as discussed in claim 1, the Yamamoto reference discloses that the camera system has more flexible option to assign or terminate the tag from the image, and the camera operator can easily decide to retain or erase the image data in the camera in any time (this can be considered as terminating on or more of said tags prior to downloading inherently).

Referring to claim 17, the Fellegara, Yamakawa, Yamamoto and Kuno references disclose all subject matter as discussed with respected to same comment as with claims 1-2 and 16.

4. Claims 3 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Fellegara et al. U.S. Patent 5,845,166 in view of Yamakawa et al. U.S. Patent 6,217,515, Yamamoto et al. U.S. Patent 6,683,650 and Theimer U.S. Patent 6,526,486.

Referring to claim 3, the Fellegara, Yamakawa and Yamamoto references disclose all subject matter as discussed in respected claim 1, except the references do not explicitly show

the retaining is for a predetermined time interval and said terminating is at the expiration of said time interval and the terminating is at the expiration of said time interval.

The Theimer reference discloses in Figures 3 and 4, a video camera system (including video camera 20, see Col. 5, lines 24-32) has a memory management method in which lifetimes (predetermined time intervals) are assigned to message (data) which are to be written into a memory, when the memory is full and further messages arrive thos stored messages whose period of activation has expired the longest are cleared (terminated) as in Figure 4 (See Col. 6, lines 22-37). The Theirmer reference is evidence that one of ordinary skill in the art at the time to see more advantages that the camera system can assign a predetermined time interval (lifetime) to retain the selected image data in the memory so that only the image data out lived their usefulness are candidates for removal and no activated data will be lost. For that reason, it would have been obvious to the camera system including means retaining is for a predetermined time interval and said terminating is at the expiration of said time interval and the terminating is at the expiration of said time interval disclosed by Fellegara.

Referring to claim 19, the Fellegara, Yamakawa, Yamamoto and Theimer references disclose all subject matter as discussed with respected to same comment as with claim 3.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438,

164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-2, 5-6, 8, 13 and 16 of copending Application No. 10/022,491 (Hereinafter referred to as '491) provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-7 and 10 (Application No. 09/946,051, hereinafter referred to as '051) in view of Fellegara et al. U.S. Patent 5,845,166.

This is a provisional obviousness-type double patenting rejection. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

Relative to claims 1, 6, 7 and 10 of '051 with claims 1, 2, 8, 13 and 16 of '491, the most limitations of claims are same as each other, such as selectively assigning individual tags to one or more of said electronic images to define tagged images having said tags and untagged images lacking said tags, etc.; except the claims 1-2, 8 and 13 of '491 does not explicitly state downloading together the tagged and untagged images to provide a set of download images external to camera.

Both claims are not distinct from each other, the Fellegara reference discloses in Figures 6-7, 14 and 19, downloading together the tagged electronic images (e.g., the digital images captured in hybrid mode has the frame number tag of a corresponding photographic file images, see Col. 15, lines 56-59) and said untagged electronic images (e.g., the digital images

captured in digital capture mode and stored on the memory without a frame number tag) to provide a set of downloaded images external to said camera as shown in Figure 19 (See Col. 19, lines 8-39). The Fellegara reference also sets forth motivation to downloading the images data to the external host computer from the camera, because the advantage of the host computer can perform more advanced image processing and making image easier to view on the larger display than camera (see Col. 19, lines 54-67 and Col. 20, lines 1-5). For that reason, it would have been obvious to the camera system also be able to download together the tagged and untagged images to provide a set of download images external to camera disclosed by '491.

Referring to claims 4-5 of '051 and claims 5-6 of '491 are the same invention.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lin Ye** whose telephone number is **(703) 305-3250**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

ANDREW CHRISTENSEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Lin Ye
September 30, 2004